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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,686	03/14/2002	John Robinson	7434-2	9238

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EXAMINER

WEINSTEIN, STEVEN L

ART UNIT PAPER NUMBER

1761

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,686

Applicant(s)

ROBINSON, JOHN

Examiner

Steven L. Weinstein

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6,8-10,19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6,8-10,19,&21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 2-6, 8-10, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holzner (4,880,649) in view of Lehrer (5,885,633) and Porzio et al (5,603,971), further in view of Soughan (6,004,593), Marmo (4,311,720), Holbradi et al (Hu 39343), Newhall (5,094,860), Soughan (5,932,260), Loizzi (5,043,172), Tucker et al (5,656,315) and Pergola et al (5,518,742).

In regard to claim 21, Holzner et al discloses a process for producing a beverage product that is used to make a flavored or aromatized infusion comprising preparing an emulsion of a flavoring and an encapsulated material suitable to produce encapsulated flavor particles, applying the emulsion to a porous carrier using a spraying process such that the encapsulant material adheres directly to the porous carrier and introducing a product to be infused into the carrier. Thus, Holzner et al teaches that a tea bag for containing tea (Example 3) are flavored by directly spraying the surface of the bag with an emulsion containing a flavoring substance and a film building water soluble carrier substance which will leave encapsulated flavor particles (col. 2, lines 32 plus – droplets of flavoring coated with the film-building vehicle) on the bag. This is applicant's objective as well. As a further point, most, if not all, examples of microencapsulation of flavors require an emulsion since the flavors are oils and the encapsulating substances are generally water soluble. Claim 21 only differs from Holzner in the recitation that a generic material printing process is employed to apply the emulsion to the porous carrier. Holzner

Art Unit: 1761

discloses that the emulsion may be applied to the porous carrier by spraying or by a belt or by a notary drum. Holzner discloses that such techniques provide a very uniform coating (col. 3, lines 3). It is noted then that the only difference between claim 21 and Holzner et al is the term 'printing' since all coating methods will be metered if for no other reason than economics. It is also noted that Holzners coating methods can also be used in "printing" methods. Thus, one could argue that the methods of coating disclosed in Holzner et al are printing methods. In any case, Lehrer can be relied on as further evidence to teach that it was conventional to apply flavoring to a surface by employing various printing techniques, both spraying techniques and other printing techniques such as screen, gravure, lithography, flexography and letter press printing (col.2, lines 53 plus). Lehrer teaches the printing permits accurate registration and minimizes waste. (col. 4. Para. 4). Lehrer also discloses the flavoring can be microencapsulated. To modify Holzner et al, if necessary, and employ printing as the coating technique for its art recognized and applicant's intended function would have been obvious. In regard to claims 2-6,8-10 and 19, since Holzner discloses all types of film-building vehicles (i.e. the capsule) including modified starches which, of course, would have adhesive properties, and since Porzio et al discloses that applicants specific modified starch n-octenyl succinate is a conventional encapsulating material for flavor, to modify Holzner et al and to employ the conventional encapsulating material for its art recognized and applicant's intended function is seen to have been obvious. The properties recited in the dependent claims for the encapsulating agents would either have been inherent in the combination or routinely determinable and selected. Soughan ('593), Marmo, Holbradi et al, Newhall, Soughan ('260), Loizzi ('172), Tucker et al ('315) and Pergola et al ('742) are relied on as further evidence of associating flavor with porous carriers.

All of applicants remarks filed 7/16/04 have been fully and carefully considered but are not found to be convincing. Since the rejection now employs Holzner et al as the primary reference, in response to the newly added claim, the urgings directed at Soughan ('593) are moot. Holzner et al unequivocally discloses preparing and applying an emulsion of a flavoring and an encapsulant material to an infusion bag. In regard to the urging that Lehrer requires two layers, Lehrer does not have to teach only one layer for the rejection to be proper since Holzner et al treats a tea bag surface just as applicant does. Also, note that the claims do not restrict the number of layers so that the urging is directed to limitations not found in the claims. However, even if the claims were so restricted, the claims would still not be patentable for the reason given above with regard to Holzner et al. It is also urged on page 4 of the amendment that Lehrer appears to have already encapsulated the material so that it may not have been applied as an emulsion of a flavoring and encapsulant material. This urging is also not convincing. The glue layer is used to bond the sheets together. The encapsulated flavor is preparing by mixing water, glue (note that starches are glue) and an encapsulated flavor. What this phrase means is that the flavor oil is in an emulsion. That is, the matrix is the adhesive/water mixture and within the matrix are encapsulated spheres of flavor oil which upon release of the water leaves shells of adhesive around the spheres or droplets. Thus, Lehrer prints or coats an emulsion onto the surface. Note, however, even if one could make a convincing argument that Lehrer does not print the emulsion, as fully detailed above, Holzner et al does employ an emulsion to coat the porous carrier using various conventional coating techniques and to employ corresponding printing techniques, if indeed there is any difference, would have been obvious in view of Lehrer

teaching the advantages of printing. Is applicant suggesting he is the first to even employ printing techniques to coat an emulsion onto a surface for any purpose?

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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Art Unit: 1761

Any inquiry concerning this communication or earlier communications from the examiner should be directed Steven Wreinstein whose telephone number is (571) 272-1412. The examiner can normally be reached on Monday-Friday from 7:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Weinstein/af
October 29, 2004

Steven Weinstein
STEVE WEINSTEIN
PRIMARY EXAMINER 1761
11/3/04